

ESTTA Tracking number: **ESTTA737897**

Filing date: **04/05/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	North American Beverages, LLC
Granted to Date of previous extension	05/04/2016
Address	6500 River Place Blvd.Bldg. 1, Suite 450 Austin, TX 78730 UNITED STATES

Attorney information	Roseann Keeler 6500 River Place Blvd.Bldg. 1, Suite 450 Austin, TX 78730 UNITED STATES roseann.keeler@bigred.com Phone:512-501-3884
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Applicant Information

Application No	86721140	Publication date	01/05/2016
Opposition Filing Date	04/05/2016	Opposition Period Ends	05/04/2016
Applicant	TOTO LIMITED TA XBIEX YACHT MARINA, TA XBIEX XBX 1027, MALTA		

Goods/Services Affected by Opposition

Class 032. First Use: 2013/03/00 First Use In Commerce: 2013/09/00 All goods and services in the class are opposed, namely: Soft drinks
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
No use of mark in commerce before application was filed	Trademark Act section 1(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	691351	Application Date	10/01/1957
Registration Date	01/12/1960	Foreign Priority Date	NONE
Word Mark	BIG RED		


Design Mark	BIG RED
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 1957/08/29 First Use In Commerce: 1957/08/29 SYRUPS FOR MAKING CARBONATED BEVERAGES

U.S. Registration No.	1628539	Application Date	11/18/1982
Registration Date	12/18/1990	Foreign Priority Date	NONE
Word Mark	BIG RED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1957/08/29 First Use In Commerce: 1957/08/29 Soft Drinks		

U.S. Registration No.	3588614	Application Date	01/31/2008
Registration Date	03/10/2009	Foreign Priority Date	NONE
Word Mark	BIG BLUE		
Design Mark	BIG BLUE		
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2008/08/15 First Use In Commerce: 2008/08/15 Concentrates, syrups or powders used in the preparation of soft drinks; Non-alcoholic beverages, namely, carbonated beverages; Soft drinks [Non-alcoholic fruit juice beverages]		

U.S. Registration No.	1694726	Application Date	06/10/1991
Registration Date	06/16/1992	Foreign Priority Date	NONE
Word Mark	BIG PEACH		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 1991/04/01 First Use In Commerce: 1991/04/01 soft drinks

U.S. Registration No.	4498786	Application Date	06/12/2012
Registration Date	03/18/2014	Foreign Priority Date	NONE
Word Mark	BIG MANZANA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2012/10/01 First Use In Commerce: 2012/10/01 Non-alcoholic beverages, namely, carbonated beverages; Soda pops; Soft drinks; Soft drinks, namely, sodas		

U.S. Registration No.	3877714	Application Date	07/01/2009
Registration Date	11/16/2010	Foreign Priority Date	NONE
Word Mark	BIG PINEAPPLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 Concentrates, syrups or powders used in the preparation of soft drinks; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages, namely, carbonated beverages; Soda pops; Soft drinks		

Attachments	72038159#TMSN.png(bytes) 77385043#TMSN.png(bytes) 85649818#TMSN.png(bytes) 77772072#TMSN.png(bytes) Notice of Opposition Big Cola 86721140.pdf(315016 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/roseann keeler/
Name	Roseann Keeler
Date	04/05/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NORTH AMERICAN BEVERAGES, LLC,

Opposer,

v.

TOTO LIMITED

Applicant.

Serial No.: 86/721,140

Mark: BIG COLA

Published in the Official Gazette on:

January 5, 2016

Opposition No. _____

NOTICE OF OPPOSITION

North American Beverages, LLC (“Opposer”) a Texas limited liability company having its principal place of business at 6500 River Place Boulevard, Building 1, Suite 450, Austin, TX 78730 believes that it will be damaged by registration of Trademark Application Serial No. 86/721,140 and hereby opposes the same pursuant to 15 U.S.C. §§ 1052 and 1063. As grounds for opposition, Opposer asserts that:

1. Upon information and belief, Toto Limited (“Applicant”), a limited liability company organized in Malta, having an address at Ta Xbiex Yacht Marina, Ta Xbiex, Level 1, Blue Harbor Business Centre, Xbx 1027, Malta, currently owns Trademark Application Serial No. 86/721,140 (“Application”).

2. On August 11, 2015, Acava Limited filed the Application based on alleged use under Section 1(a) of the Lanham Act to register the mark BIG COLA in the following form:



for use in connection with the sale of soft drinks. The Application alleges that the BIG COLA mark was first used in commerce in September of 2013.

3. In October 2015, Applicant purchased Acava Limited's interest in the Application and recorded the assignment.

4. Opposer is the owner of the following United States Trademark Registrations (collectively, the "BIG Marks") which are valid and in full force and effect:

Trademark	Registration No.	Filing Date	Registration Date	Date of First Use	International Class/Goods
BIG RED	691,351	10/01/1957	01/12/1960	08/29/1957	032- Syrups for making carbonated beverages
BIG RED	1,628,539	11/18/1982	12/18/1990	08/29/1957	032- Soft Drinks
BIG BLUE	3,588,614	01/31/2008	03/10/2009	08/15/2008	032- Concentrates, syrups or powders used in the preparation of soft drinks; Non-alcoholic beverages, namely, carbonated beverages; Soft drinks
BIG PEACH	1,694,726	06/10/1991	06/16/1992	04/01/1991	032- Soft Drinks
BIG MANZANA	4,498,786	06/12/2012	03/18/2014	10/01/2012	032- Non-alcoholic beverages, namely, carbonated beverages; Soda pops; Soft drinks, namely, sodas
BIG PINEAPPLE	3,877,714	07/01/2009	11/16/2010	06/01/1996	032- Concentrates, syrups or powders used in the preparation of soft drinks; Non-alcoholic beverages, namely carbonated beverages; Soda pops; Soft drinks

5. Opposer and its predecessors in interest's use of the BIG Marks have been valid and continuous in connection with the sales of the goods listed above across the United States since their respective first dates of use.

6. Opposer and its predecessors, for many years and long prior to any alleged date of first use upon which Applicant can rely, have adopted and continuously used the BIG Marks in the United States in connection with soda and soft drinks. Opposer and its predecessors in interest have used some of the BIG Marks in commerce in the United States from at least as early as 1957.

7. Opposer's BIG Marks are symbolic of extensive goodwill, and have acquired a high degree of recognition through continued use and expenditures of time, effort, and money in advertising and promotions, and serve as unique identifiers as to the source of Opposer's goods.

8. Opposer has priority of use because Opposer's use of the BIG Marks in commerce predates any alleged use in commerce by Applicant of the BIG COLA mark.

9. The BIG Marks' Registrations are *prima facie* evidence of Opposer's exclusive right to use the BIG Marks in commerce in the goods specified above.

10. Applicant's BIG COLA mark, to be used in connection with soft drinks, so resembles Opposer's previously used and registered BIG Marks as to be likely, when used in connection with the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act. Opposer asserts that Applicant's proposed BIG COLA mark is confusingly similar to Opposer's BIG Marks as used and registered by Opposer and should therefore not be registered. Specifically, the dominant "BIG" in Applicant's BIG COLA mark evokes the same or highly similar connotations as

Petitioner's BIG Marks and is likely to cause confusion, mistake, or deception, by suggesting Applicant's soft drinks are associated with Opposer's soft drinks.

11. The goods to which Applicant's BIG COLA mark will be applied, soft drinks, are identical to the goods Opposer applies its BIG Marks. These goods are offered to and sold through the same channels of commerce, are sold to the same class of purchaser, are relatively low-priced, and may be purchased on impulse by consumers. Consumers and prospective consumers may believe that Applicant is associated with, affiliated with, sanctioned by, or licensed by Opposer, or that the BIG COLA trademarked goods are Opposer's trademarked goods or are a brand extension of Opposer's broad range of BIG Marks. When consumers see and hear Opposer's BIG Marks family of trademarks and Applicant's BIG COLA trademark, they will incorrectly believe the trademarks and connected goods originate from the same source or are the product of a joint effort or collaboration.

12. Opposer's BIG Marks are famous and were famous before the alleged first use of the BIG COLA mark by Applicant or Applicant's application filing date. Applicant's BIG COLA mark is likely to dilute the fame and strength of Opposer's BIG Marks family of trademarks. This likelihood of dilution will be of great detriment to Opposer.

Likelihood of Confusion

13. Opposer incorporates by reference each allegation set forth above.

14. Due to the fame of Opposer's BIG Marks, the similarity of Applicant's BIG COLA mark, the similarity of the channels of trade, the related nature of the goods, and the relatively low price of the goods, Applicant's BIG COLA mark so resembles Opposer's BIG Marks that it is likely to cause confusion, mistake, or deception by suggesting that Applicant's soft drinks are associated with or approved, endorsed, affiliated, or authorized by Opposer.

Lack of Bona Fide Use

15. Opposer incorporates by reference each allegation set forth above.

15. Upon information and belief, the BIG COLA mark was not being used in interstate commerce in 2013, is not currently being used in commerce, and has never been used in commerce in connection with the sale of soft drinks.

16. The Application should be refused registration because there has been no use of the BIG COLA mark in commerce as of the date of the filing of the Lanham Act Section 1(a) use based application and the Application is void *ab initio* under Lanham Act Section 1(a).

Fraud

17. Opposer incorporates by reference each allegation set forth above.

18. The Application falsely states the BIG COLA mark has been and is currently being used in commerce. This representation was made knowingly with an intent to deceive the United States Patent and Trademark Office in order to achieve registration of the BIG COLA mark.

WHEREFORE, Opposer requests that this opposition be sustained and that Trademark Application Serial No. 86/721,140 be refused.

Dated: April 5, 2016

Respectfully Submitted

/Roseann Keeler/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing Notice of Opposition has been served on April 5, 2016, via certified U.S. First Class Mail addressed to Applicant's Correspondent of Record at the address given on the TSDR website:

Justin Young
Dineff Trademark Law Limited
160 N. Wacker Dr.
Chicago, IL 60606

/Roseann Keeler/

Roseann Keeler, Esq.